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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/656,164 | 09/08/2003 | Juergen Schubert | 237228US0 | 1323 |
| 22850 | 7590 | 09/07/2006 | EXAMINER | |
| C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | PARVINI, PEGAH | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1755 | |

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 10/656,164 | | SCHUBERT ET AL. | |
| | Examiner | | Art Unit | |
| | Pegah Parvini | | 1755 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/8/2003, 6/2/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because the abstract is not descriptive and is an incomplete sentence. Correction is required. See MPEP § 608.01(b).
3. The disclosure is objected to because of the following informalities: The references made to DE 10 058 616 (Page 4, Lines 21) and to German priority application 102 41 273.1 (Page 9, Lines 8-9) for purpose of incorporation by reference are improper.

Appropriate correction is required.

The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material

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incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

4. The disclosure is objected to because of the following informalities: European application number should be EP 0 922 671 (Page 6, Line 3).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4 and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by CA 2255456 (cited from Canadian Patent Office) to Siray et al.

7. Relating to claim 1, Siray et al. disclose a precipitated silica with the following physico-chemical parameters: 400-600 of BET surface area in m²/g; 300-360 of DBP index in g/100g; 70-140 of compacted (tamped) density in g/l (Page 2, Lines 29-30, and

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Page 3, Lines 1-3). In addition, the results of Example 3 (Page 6, Lines 25-32), which are given in Table 3 (Page 12) disclose the d50 values which are all in the range of 5-15microns.

8. Relating to claim 2, Siray et al. disclose the values of d10, and d90 as provided in Table 3 (Page 12) using which the particle size distribution as defined in the claim by applicant ($[d90-d10]/d50$) is calculated for each sample and found to be in the range of 0.90-1.5 for all the different samples in the top table of Table 3 (Page 12) and for all except "4b, fine" sample in the bottom table of Table 3 (Page 12).

9. Relating to claims 3-4, Siray et al. disclose the gloss angle values for 60° and 85° for the samples in Table 3 (Page 12), and they are all in the range of 15-25 and 50-70 for the angles of 60° and 85° respectively.

10. With regards to claim 13, Siray et al. disclose a sample of a precipitated silica coated with a wax emulsion namely "8b" containing the following physico-chemical characteristics: 351-600 of BET surface area in m^2/g ; 300-360 of DBP index as a %; 1-8% of Carbon content; 7-140 of compacted (tamped) density in g/l. Furthermore, in example 8 (Page 22, Lines 28-37, and Page 23), Siray et al. disclose a silica suspension coated with wax with carbon content of 3.4%, DBP of 330 g/100g, surface area of 333 m^2/g ; density of 87 g/l, and d50 of 8.21.

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11. With regards to claim 14, Siray et al. disclose the above-mentioned precipitated silica with wax having the values of 12.28 for d90, 8.21 for d50, and 4.66 for d10 based on Table 12 (Page 23, Liens 26-end) which result in the size distribution of 0.928 based on $[d90-d10]/d50$.

12. With regards to claims 15-16, Siray et al. disclose the gloss angle values for the above-mentioned sample "8b" as 17.3, 42.9 and 34.4, 67.4 for angles of 60° and 85° respectively (Table 13 and 14, Page 24). The tables indicate results for the silica used in the lacquer.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 6-12 and 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5034207 to Kerner et al. in view of CA 2255456 to Siray et al.

15. With reference to claims 6-12, and 17-24, Kerner et al. disclose a paint and method for increasing the matting effect through the inclusion of precipitated silica as a matting agent therein (Column 1, Lines 16-19). Kerner et al., however, is silent as to the

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use of the specifically claimed precipitated silica materials as required by applicants' claims 1-4 and 13-16. Siray et al. as set forth in the rejection above, disclose precipitated silica having the properties as required in applicant claims 1-4 and 13-16. It would have been obvious to one of ordinary skill in the art at the time of invention to utilize the precipitated silica of Siray et al. in the paints of Kerner et al. motivated by the fact that Siray et al. disclose that the instant silica compositions are advantageous in that they have a particularly high matting efficiency, provide a very smooth surface to the final paint coating and also provide high transparency while minimizing deleterious effects upon the paint rheology (Page 5, Lines 13-17).

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,921,781 B2 to Schubert et al.

U.S. Patent No. 4,495,167 to Nauroth et al.

U.S. Patent No. 6,383,280 B1 to Siray et al.

U.S. Patent No. 6,902,715 B2 to Maus et al.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pegah Parvini whose telephone number is 571-272-2639. The examiner can normally be reached on Monday to Friday 8:00am-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PP


J. A. LORENGO
SUPERVISORY PATENT EXAMINER